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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,720	10/18/2001	Moshe Rock	10638-025001	8722

26161 7590 06/13/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 11

Office Action Summary	Application No.		Applicant(s)	
	09/982,720		ROCK ET AL.	
	Examiner		Art Unit	
	Jenna-Leigh Befumo		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 27 and 37, drawn to a double-face velour fabric having a defined filament stitch yarn, classified in class 428, subclass 95.
 - II. Claims 28 - 32 and 37, drawn to a double-face velour fabric having a defined filament stitch yarn, classified in class 428, subclass 95.
 - III. Claims 33 - 37, drawn to a double-faced velour fabric wherein the fibers are entangled, classified in class 428, subclass 92.
 - * It is noted that claim 37 is included in Groups I through III, this is because claim 37 depends from either claim 1, 28, 33, or 35. Therefore, if Group I is elected, claim 37 will be interpreted based on the limitations in claim 1. And if Group II is elected, claim 37 will be interpreted based on the limitations in claim 28. And if Group III is elected, claim 37 will be interpreted based on the limitations in claims 33 or 35 .
 - IV. Claim 38, drawn to a method of making a double-faced velour fabric via heat treating the fabric, classified in class 264, subclass 405.
 - V. Claims 39 - 52, drawn to a method of making a double-faced velour fabric via entangling the fabric, classified in class 28, subclass 103.
 - VI. Claims 53 - 54, drawn to method of making a double-faced velour fabric with an elastomeric yarn, classified in class 66, subclass 7.

The inventions are distinct, each from the other because of the following reasons:

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2. Inventions I, IV, and V and Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are have different effects. Inventions II and VI do not need to be heat treated to produce the finished fabric. Instead the article produced in Invention II and VI comprises an elastomeric filament stitch yarn, while the heat treatment step creates permanent changes by bonding and shrinking the heat sensitive material in Inventions I, IV, and V. Therefore, Inventions II and VI produce a more flexible fabric with more elasticity than Inventions I, IV, and V.

3. Inventions I, II, and IV – VI and Invention III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. While all the inventions are velour fabrics, Invention III does not require the use of a specific filament stitch yarn. Instead, Invention III is drawn to a velour fabric wherein the fabric surface is entangled and not otherwise treated. While Inventions I, II, and IV – VI are produced by heat treating the fabric, which bonds and shrinks the filaments, or by using elastic filaments which would produce an elastic and flexible fabric. Thus, the final products would have different textures and visual appearances.

4. Inventions IV and V and Invention I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

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instant case the fabric can be made without the finishing step of the method claims by employing chenille yarns which already have a velour texture.

5. Inventions VI and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the fabric can be made without the finishing step of the method claims by employing chenille yarns which already have a velour texture.

6. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different effects. While both inventions are drawn to heat treating the velour fabric, Invention V additionally requires that the fabric is entangled on one surface. This not only adds an additional step not required by Invention IV, but would also create a fabric with a different surface feel and appearance.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. If the Applicant chooses Group I then the following species election is required.

9. This application contains claims directed to the following patentably distinct species of the claimed invention: a) a double-face velour fabric where the filament stitch yarn comprises a heat sensitive material and an elastomeric material, b) a double-face velour fabric where the

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filament loop yarn is splitable, and c) a double-face velour fabric where at least one surface of the fabric is entangled.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 – 9, 16, 17, 18, 24, 25, and 37 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Due to the complexity of the restriction a telephone call was not made to request an oral election to the above restriction requirement.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
June 11, 2003



CHERYL A. JUSKA
PRIMARY EXAMINER